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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CRAIG L. REDING and CHRISTOPHER HELBLING

Appeal 2009-007305
Application 10/720,970
Technology Center 2600

Before JOHN C. MARTIN, MAHSHID D. SAADAT,
and THOMAS S. HAHN, *Administrative Patent Judges*.

SAADAT, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304 or for filing a request for rehearing as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

Appellants appeal under 35 U.S.C. § 134(a) from a Final Rejection of claims 1, 2, 4-6, 8-16, and 18-22, which constitute all the claims pending in this application. Claims 3, 7, and 17 are cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part and institute a new ground of rejection within the provisions of 37 C.F.R. § 41.50(b).

STATEMENT OF THE CASE

Appellants' invention relates to managing a plurality of communications devices associated with a user of a communications network. For example, upon receiving an indication that a first communications device, e.g., a cellular telephone, has entered a vicinity (or range) of a second communications device, e.g., a land line telephone, calls intended for either communications device are forwarded to the second communications device. Upon receiving an indication that the first communications device has left the vicinity of the second communications device, calls intended for either communications device are forwarded to the first communications device. This may be accomplished by using a protocol such as the Bluetooth protocol, the IEEE 802.11(b) protocol, and/or the IEEE 802.11(g) protocol. (Abstract.) The second communications device (e.g., an office phone) can be located next to a user terminal that includes a transceiver for detecting the presence of the first communications terminal. Spec. ¶¶ [0101], [0103].

Claims 1 and 4, which are illustrative of the invention, read as follows:

1. A method for managing calls directed to a plurality of communications devices associated with a user, comprising:

receiving user-defined preferences regarding handling of calls directed to the plurality of communications devices;

storing the user-defined preferences;

receiving an indication that a first one of the communications devices has moved within wireless communication range of a terminal; and

forwarding calls intended for at least two of the communications devices to a second one of the communications devices in response to receipt of the indication and based on the user-defined preferences.

4. A method as recited in claim 1, further comprising:

receiving a second indication that the first communications device has moved outside of wireless communication range of the terminal; and

terminating the forwarding of calls to the second communications device in response to receipt of the second indication; and

forwarding calls intended for at least two of the communications devices to the first communications device in response to receipt of the second indication.

The Examiner relies on the following prior art in rejecting the claims:

Holloway US 2003/0092451 A1 May 15, 2003

Claims 1, 11, 21, and 22 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite.²

Claims 1, 2, 4-6, 8-16, and 18-22 stand rejected under 35 U.S.C. § 102(e) as anticipated by Holloway.

² The rejection of claims 1, 11, 21, and 22 under 35 U.S.C. § 112, first paragraph (Final Rej. 3), has been withdrawn by the Examiner (Ans. 12).

Rather than repeat the arguments here, we make reference to the Brief (filed Jan. 29, 2007) and the Answer (mailed May 9, 2007) for the respective positions of Appellants and the Examiner. Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants did not make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUES

The pivotal issues presented by the appeal are:

1. Does the phrase “forwarding calls intended for at least two of the communications devices to a second one of the communications devices,” as properly construed, render claim 1 indefinite?

2. Does Holloway disclose

receiving an indication that a first one of the communications devices has moved within wireless communication range of a terminal; and

forwarding calls intended for at least two of the communications devices to a second one of the communications devices in response to receipt of the indication and based on the user-defined preferences

as recited in claim 1?

3. Does Holloway disclose

receiving a second indication that the first communications device has moved outside of wireless communication range of the terminal; and

terminating the forwarding of calls to the second communications device in response to receipt of the second indication; and

forwarding calls intended for at least two of the communications devices to the first communications device in response to receipt of the second indication as recited in claim 4?

FINDINGS OF FACT (FF)

Holloway

1. Holloway discloses that when a mobile phone 110 is outside the range 120 of a transmitter associated with a preferred phone 130, each of the phones 110, 130 will receive calls intended for its own number (Fig. 1A; ¶¶ [0014]-[0015]; *see also* ¶ [0017]).

2. Holloway discloses that when the mobile phone 110 has entered the range 120 of the transmitter associated with the preferred phone 130, calls to the mobile phone 110 are forwarded to the preferred phone 130 (Fig. 1B; ¶¶ [0014]-[0015]; *see also* ¶ [0017]).

3. Holloway discloses that the transmitter can be programmed to recognize different mobile phones and to transfer each mobile phone to a different extension, such as in a business where multiple employees utilize mobile phones or in homes where both spouses carry mobile phones (¶ [0022]).

Appellants' Specification

4. The Specification discloses that computer-readable media include “secondary storage devices, like hard disks, floppy disks, and CD-ROM; a carrier wave received from a network such as the Internet; or other forms of ROM or RAM” (¶ [0128]).

5. The Specification discloses that a user-defined preference 804, when selected, causes calls intended for the office phone 602 to be forwarded to the office phone 602 (Fig. 8; ¶ [0097]).

PRINCIPLES OF LAW

In order to satisfy the second paragraph of § 112, the claims must “set out and circumscribe a particular area with a reasonable degree of precision and particularity.” *In re Johnson*, 558 F.2d 1008, 1015 (CCPA 1977). Furthermore, “the definiteness of the language employed must be analyzed not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art.” *Id.*

[T]he [US]PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant’s specification.

In re Morris, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

ANALYSIS

35 U.S.C. § 112, Second Paragraph, Rejection

In rejecting claim 1 as indefinite, the Examiner points to the phrase “forwarding calls intended for at least two of the communications devices to a second one of the communications devices” as being unclear (Ans. 4). The Examiner takes the position that it is unclear whether the phrase only covers forwarding of an individual call that is intended by the sender to be received

at the same exact time by two communications devices, which the Examiner characterizes as “impossible” (Ans. 4, 12-13).

Appellants contend that “the Examiner appears to be reading a limitation into claim 1 that does not exist” (Br. 13; *see also* Br. 14). Appellants also “assert that claim 1 clearly recites that the calls are merely a number of calls intended for the claimed communications devices” (Br. 13; *see also* Br. 14).

We agree with Appellants. The construction given to the phrase by the Examiner is at odds both with the overall teaching of the Specification and with how the phrase would be understood by one having ordinary skill in the art. *See In re Johnson*, 558 F.2d at 1015. We find that the disputed phrase would be understood by one having ordinary skill in the art as having the meaning asserted by Appellants. In other words, the phrase reads on a call directed to any one of the at least two communications devices. Accordingly, we do not sustain the 35 U.S.C. § 112, second paragraph, rejection of claim 1, as well as claims 11, 21, and 22 that include similar limitations as those in claim 1, which we found *supra* to be definite.

35 U.S.C. § 102(e) Rejection

Claims 1, 2, 5, 6, 8-13, 15, and 18-20

Appellants contend that Holloway does not disclose “forwarding calls intended for at least two of the communications devices to a second one of the communications devices in response to receipt of the indication and based on the user-defined preferences,” as recited in claim 1 (Br. 16). The Examiner (Sept. 7, 2006, Advisory Action) reads this claim language on the following Holloway passage, which refers to Figures 2 and 3:

When mobile phone 230 comes within the range of transmitter

220, mobile phone 230 receives the transmitted signal (step 310). In step 320, phone 230 sends an overhead message to cellular system 210 requesting forwarding of calls to preferred phone 240 (step 320) and passing on the appropriate phone number for forwarding.

Holloway ¶ [0017]. Giving the above claim language its broadest reasonable interpretation, *see Morris*, 127 F.3d at 1054, we find the Examiner's claim construction and reading of the claim on mobile phone 230 and preferred phone 240 to be reasonable (FF 2, 3). That is, the claim language is broad enough to read on the combination of: (a) sending calls intended for the second communications device (Holloway's preferred phone 230) to the second communications device whether or not there is an indication that the first communications device is within wireless communication range of the terminal (Holloway's transmitter 220); and (b) sending calls intended for the first communications device (mobile phone 230) to the second communications device (preferred phone 240) in response to an indication that the first communications device (mobile phone 230) is within wireless communication range of the terminal (transmitter 220). The claim does not require that forwarding of *each* of the calls intended for the at least two communications devices be based on receipt of the recited "indication." For this reason, we find that Holloway discloses forwarding calls intended for at least two communications devices (Holloway's mobile phone 230 and preferred phone 240) to the second communications device (FF 2) in response to receipt of the indication and based on the user-defined preferences.

For the foregoing reasons, it is not necessary to address the Examiner's alternative reliance (Ans. 13-14) on Holloway's paragraph [0022], which describes recognizing different mobile phones associated with

a transmitter and transferring each mobile phone to a different extension (FF 5).

Regarding the rejection of claims 2, 5, 6, 8-13, 15, and 18-20, Appellants rely on substantially the same arguments presented for claim 1 (Br. 14-19). Accordingly, we sustain the 35 U.S.C. § 102(e) rejection of claim 1 as well as claims 2, 5, 6, 8-13, 15, and 18-20, which fall with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Claims 4, 14, 16, 21, and 22

Appellants contend that Holloway does not disclose forwarding calls intended for the second communications device (Holloway's preferred phone) to the first communications device (Holloway's mobile phone) in response to receipt of a signal indicating that the first communications device is outside of wireless communication range of the transmitter associated with the second communications device (Br. 17). For this reason, Appellants contend, Holloway does not disclose forwarding calls intended for at least two of the communications devices to the first communications device in response to such a signal, as recited in claim 4 (Br. 17). Additionally, Appellants argue the patentability of claims 14, 16, 21, and 22 by relying on substantially the same rationale as argued for claims 1 and 4 (Br. 19-23).

The Examiner responds that "Holloway discloses that when . . . the mobile phone is able to recognize that it is no longer receiving the signal from the transmitter, the mobile phone sends a request to the communication system to terminate forwarding calls from other communication devices to the preferred phone (see [0017])" (Ans. 14-15). The Examiner further responds that when "the communication system stops forwarding calls from

other communication devices to the preferred phone, calls from other communication devices will be forwarded directly to the mobile phone” (Ans. 15).

We agree with Appellants’ position. We do not find in Holloway any disclosure of forwarding calls *intended for*, as distinct from “*from*,” any other communications device to Holloway’s mobile phone. In Holloway, when the mobile phone moves beyond the range of the transmitter associated with the preferred phone, calls intended for the preferred phone continue to be forwarded to the preferred phone and calls intended for the mobile phone commence being forwarded to the mobile phone (FF 1). Therefore, we conclude that the disputed limitation of claim 4 is not met by Holloway’s disclosure. Accordingly, we do not sustain the rejection of claim 4 or of claims 14, 16, 21, and 22, which include the same limitation we found to be absent from Holloway.

New Ground of Rejection within 37 C.F.R. § 41.50(b)

Claim 22 is rejected under 35 U.S.C. § 101 as being drawn to non-statutory subject matter.

Our reviewing court has found that transitory, propagating signals such as carrier waves are not within any of the four statutory categories (process, machine, manufacture, or composition of matter). Therefore, a claim directed to computer instructions embodied in a signal is not statutory under 35 U.S.C. § 101. *In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007).

“A transitory, propagating signal [however] . . . is not a ‘process, machine, manufacture, or composition of matter.’ [These] four categories define the explicit scope and reach of subject matter patentable under 35 U.S.C. § 101; thus, such a signal cannot be patentable subject matter.”

Nuijten, 500 F.3d at 1357. Specifically, signals are unpatentable as failing a *tangibility* requirement to be “manufactures” because they are not *tangible* media. *Nuijten*, 500 F.3d at 1366.

Claim 22 recites “[a] computer-readable medium,” which, based on Appellants’ Specification, may be “a carrier wave received from a network such as the Internet” (FF 4). Although a network is a tangible item, a carrier wave received from a network is *not* a tangible storage medium capable of storing instructions. Accordingly, we find that a “computer-readable medium” as recited in claim 22 includes a carrier wave that merely transports computer instructions in a signal, which is non-statutory subject matter. Therefore, we enter a new ground of rejection, rejecting claim 22 as covering non-statutory subject matter under 35 U.S.C. § 101.

ORDER

The decision of the Examiner to reject claims 1, 2, 5, 6, 8-13, 15, and 18-20 is affirmed. The decision of the Examiner to reject claims 4, 14, 16, 21, and 22 is reversed.

We enter a new ground of rejection for claim 22 under 35 U.S.C. § 101.

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides that “[a] new ground of rejection . . . shall not be considered final for judicial review.”

Section 41.50(b) also provides that Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

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(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record.

37 C.F.R. § 41.50(b) (emphases added).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1).

AFFIRMED-IN-PART;
37 C.F.R. § 41.50(b)

babc

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